

The form PCT/DO/EO/903 forwarded to applicants by the PCT Branch of the U.S. Patent and Trademark Office acknowledges receipt of "priority document". The present application claims priority from three earlier filed Japanese applications as identified in the declaration/power of attorney form filed upon entry of the U.S. national stage. Acknowledgement by the PTO of the receipt of applicants' papers filed under Section 119 would be appreciated.

Claims 1-9 have been rejected under the second paragraph of Section 112. This rejection is respectfully traversed.

The language "almost uniformly milling" has been criticized as indefinite. This phrase means milling to almost the same particle size. Applicants' specification states at page 4, lines 16-20, "in the thawing method of the present invention, such a frozen ground fish meat mass is first milled to pieces of such a size as being thawed almost uniformly as a whole. It is preferable to mill the mass into pieces of 20mm or less in size." In deference to the examiner's views and to even better particularly point out and distinctly claim the invention, the language in claim 1 has been changed to use more standard American-style phraseology. No limitation is added and none is intended.

Withdrawal of the rejection is in order and is respectfully requested.

Claims 8 and 9 have also been rejected under the second paragraph of Section 112. This rejection is respectfully traversed.

First, applicants respectfully disagree that these claims constitute an improper combination of method of using and method of making. The steps recited in claims 8 and 9 are merely extensions of the steps recited in claim 7. These steps can all be carried out in a single sequence, or can be separated in time. Regardless, claims 8 and 9 properly recite complete processes.

Moreover, applicants respectfully note that they are aware of no authority for the statement appearing in the last two lines of numbered page 2 of the Official Action. If there is any authority for this position, it would be appreciated if the examiner would cite same. In any event, and even if there is no authority for such position, applicants would be willing to rewrite claim 8 in independent form if the examiner remains adamant.

Withdrawal of the rejection is in order and is respectfully requested.

Claims 1-7 have been rejected as obvious under Section 103 from Kato et al in view of JP '049, a translation of the latter being filed herewith. This rejection is respectfully traversed.

As regards the secondary reference (JP '049), attention is respectfully invited to lines 9-6 from the bottom of page 4 stating that frozen fish meat was cut into thin

strips using a frozen cutter, and other forms of fish meat were shaped into sticks of approximately 5 cm thick, approximately 5 cm wide and approximately 20 cm long. Please also refer to lines 2-5 on page 7 stating that the frozen ground fish meat was used in two ways as (1) unthawed and cut into pieces of 0.5 to 1 cm thick and 5 cm square, and (2) allowed to stand overnight at 5°C. JP 60-70049 does not suggest the advantageous effects of substantially uniformly milling of the present invention. Consequently, JP '049 does not make up for the acknowledged deficiencies of Kato as pointed out below, and the prior art provides no incentive for the proposed combination.

Considering next the primary reference, Kato, it simply does not mill a frozen ground fish meat mass as required according to the present invention, and this is believed to be recognized by the PTO. Kato merely mills a thawed ground fish meat mass. Why would one skilled in the art mill a frozen ground fish meat mass in view of either Kato or JP '046? There is no reason to do so, and indeed there is disincentive to do so because such milling of a frozen mass takes more energy and is more expensive than the milling of a thawed ground meat fish mass. The advantages achieved by the present invention not having been known or recognized or predictable from the prior art, no person of ordinary skill in the prior art would have gone to the extra cost of milling a frozen mass when no advantages to doing so would have been foreseeable. Kato does not mention or suggest the advantageous effects of milling of a frozen ground fish meat mass as set forth in the specification,

and neither does any other known prior art.

Returning briefly to the secondary reference (JP '049), it also does not teach the milling of a frozen ground fish meat mass. Therefore, no combination of the two references, even if obvious (respectfully denied by applicants), could result in the claimed process.

Withdrawal of the rejection is in order and is respectfully requested.

Claims 8 and 9 have been similarly rejected further in view JP '739. This rejection is also respectfully traversed.

JP '739 has not been cited to make up for the above noted deficiencies of the primary and secondary references as discussed above, and indeed it does not so. Therefore, even if JP '739 indeed disclosed and taught what is stated in the rejection, its combination with Kato would not provide the claimed subject matter. Moreover, it should briefly be mentioned that the improved products obtained by the present invention as called for in claims 8 and 9 are dependent on the key step recited in claim 7 (and claim 1) of milling the frozen ground meat mass; therefore, claims 8 and 9 produce an unexpectedly improved product, i.e. an improved result, and therefore call for unobvious subject matter "as a whole".

Withdrawal of the rejection is in order and is respectfully requested.

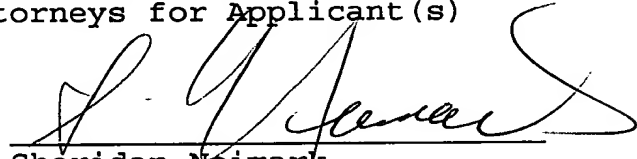
New claims 10-12 have been added which restore the variation in claim language cancelled previously by eliminating the multidependency of claim 6 when the present application entered the national stage, by virtue of a preliminary amendment filed at that time. These claims are clearly patentable for the same reasons as the other claims including claims 3-6.

Favorable reconsideration and allowance are earnestly solicited.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.  
Attorneys for Applicant(s)

By

  
Sheridan Neimark  
Registration No. 20,520

SN:jec  
Telephone No.: (202) 628-5197  
Facsimile No.: (202) 737-3528

\\itt1\amd\hoashi2